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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,317	05/01/2001	Naomi Noda	WATK : 212	2258

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PARKHURST & WENDEL, L.L.P.
1421 Prince Street, Suite 210
Alexandria, VA 22314-2805

EXAMINER

JOHNSON, EDWARD M

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 09/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,317

Applicant(s)

NODA ET AL.

Examiner

Edward M. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/47864.

Regarding claim 1, WO '864 discloses a catalyst comprising a support for a catalyst layer containing potassium (see page 17, first full paragraph), wherein the support contains 0.6-5 wt% silica (see page 19, third full paragraph).

Regarding claim 2, WO '864 discloses 0.6-5 wt% silica (see page 19, third full paragraph).

Regarding claim 5, WO '864 discloses magnesium (see page 18, first paragraph).

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Regarding claim 6, WO '864 discloses potassium (see page 17, first full paragraph).

Regarding claim 7, WO '864 discloses a honeycomb shape (see page 21, first full paragraph).

Regarding claim 8, WO '864 discloses Pt, Rh, and Pd (see page 19, second full paragraph).

3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Freudenberg et al. US 5,153,153.

Regarding claim 1, Freudenberg '153 discloses catalysts comprising MgO on a 2.5-5% silica support (abstract).

Regarding claim 2, Freudenberg '153 discloses 2.5-5% silica (see abstract).

Regarding claim 3, Freudenberg '153 discloses TECs of $0.75 \times 10^{-6}/K$ to $2.9 \times 10^{-6}/K$ (see Table IV).

Regarding claim 4, Freudenberg '153 discloses aluminum titanate (title).

Regarding claim 5, Freudenberg '153 discloses MgO (abstract).

4. Claims 1-2 and 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Hori et al. US 6,555,081.

Regarding claim 1, Hori '081 discloses an exhaust gas purification catalyst comprising a carrier for an alkali metal

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(abstract), wherein the carrier contains 5% silica (see Example 4).

Regarding claim 2, Hori '081 discloses 5% silica (see Example 4).

Regarding claim 4, Hori '081 discloses aluminum titanate (see column 7, lines 39-41).

Regarding claim 5, Hori '081 discloses magnesium (see column 5, lines 41-42).

Regarding claim 6, Hori '081 discloses potassium (see column 5, lines 41-42).

Regarding claim 7, Hori '081 discloses honeycomb carrier (see column 7, lines 41-47).

Regarding claim 8, Hori '081 discloses platinum and palladium (see abstract).

Response to Arguments

5. Applicant's arguments filed 8/13/03 have been fully considered but they are not persuasive.

The rejection under 35 USC §112(2) has been withdrawn in view of Applicant's amendment.

It is argued that thus has been added to improve... purification rate. This is not persuasive because Applicant merely claims a carrier that comprises silicon, which applicant appears to admit is present in the prior art support in the form

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of a washcoat. It is noted that the features upon which applicant relies (i.e., silicon which is present in some specific way other than a washcoat or "before forming the carrier structure") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is argued that Freudenberg et al. discloses... casting process. This is not persuasive because Applicant appears to admit that the disclosed composition "can be used as a catalyst support", as disclosed. And, in any case, Applicant does not claim silicon "to improve the catalytic activity of a NOx catalyst". It is noted that the features upon which applicant relies (i.e., silicon "to improve the catalytic activity of a NOx catalyst") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, and in any case, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

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invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

It is argued that in the rejection of claim 5... citing the Abstract. This is not persuasive because Applicant appears to admit that silicon and MgO are both disclosed and Applicant does not claim activity of a NOx catalyst (see above).

It is argued that the silicon oxide... support for Pt. This is not persuasive because Applicant merely claims a carrier that comprises silicon, which applicant appears to admit is present in the prior art support in the form of a washcoat. It is noted that the features upon which applicant relies (i.e., silicon "to improve the catalytic activity of a NOx catalyst") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is argued that the Examiner cites Example 4 as showing 5% silica. This is not persuasive because Applicant appears to admit that 5% silica is disclosed and that it is used as

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"support for Pt". The claim reads on these disclosures. The embodiment set forth in Example 7 is not currently relied upon by the Examiner for this limitation.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward M. Johnson whose telephone number is 703-305-0216. The examiner can normally be reached on M-F 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman

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can be reached on 703-308-3837. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

EMJ

September 15, 2003

**STEVEN BOS
PRIMARY EXAMINER
GROUP 1100**

A handwritten signature in black ink, appearing to read 'S. Bos', is written over the printed name and title.